

In re Application of: Hanan KEREN et al
Serial No.: 10/556,483
Filed: May 10, 2004
Office Action Mailing Date: February 18, 2009

Examiner: PATRICIA C MALLARI
Group Art Unit: 3735
Attorney Docket: 30811

REMARKS

The present Office Action restricts the claims into two different groups. Applicants elect Group I (claims 75-116) with traverse. Restriction is only proper when there is a serious search burden on the Examiner and the inventions are independent. MPEP § 803 (I) describes the criteria for restricting between patentably distinct inventions. For example, the MPEP states that:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §808, and §808.02).

Moreover, MPEP § 803 (II) states that the Examiner must provide appropriate information related to indicate a serious search burden, or show that the inventions belong to different classes or to different fields for the restriction to be proper. In the present case, the examiner provides a general statement that U.S. Patent Nos. 5,642,734 and 6,076,393 show that there is a lack of a single unifying novel inventive concept linking the independent claims such that there is a lack of unity of invention, and that the remaining subject matter of the independent claims of Group I and Group II are related only as a method and apparatus for carrying out the method.

The Examiner, however, does not provide appropriate information related to the differences that would necessitate separate searches and thus be serious burden on the Examiner.

This line of reasoning is incorrect and compels the Applicants to conclude that the PTO imposed restriction requirement with respect to groups I and II is improper.

In re Application of: Hanan KEREN et al
Serial No.: 10/556,483
Filed: May 10, 2004
Office Action Mailing Date: February 18, 2009

Examiner: PATRICIA C MALLARI
Group Art Unit: 3735
Attorney Docket: 30811

It is submitted that although claims 75-116 belong to a different category than claims 117-145, the limitations found the claims in group I are the same as the limitation found in the claims of group II.

Applicants therefore request reconsideration and withdrawal of the restriction requirement. Applicants also retain the right to pursue the inventions belonging to the non-elected groups in additional divisional applications that claim priority to the present application.

Respectfully submitted,


Martin D. Moynihan
Registration No. 40,338

Date: March 11, 2009